

REMARKS/ARGUMENTS

Prior to entry of this amendment, the application included claims 11-17, 19-23 and 32-64. An Office Action mailed February 21, 2006, rejected claims 56 and 57 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 55 and 57 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claims 16, 17, 19, 33, 37-40, 45-51, 60, 61, 63 and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,049,811 to Petruzzi et al. (“Petruzzi”) in view of US Publication No. 2001/0049707 to Tran (“Tran”). Claim 52 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran as applied to claim 50, and further in view of US Patent No. 5,778,398 to Nagashima et al. (“Nagashima”). Claims 53, 56 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran as applied to claim 50, and further in view of US Patent No. 6,484,149 to Jammes et al. (“Jammes”). Claims 54 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran as applied to claim 45, and further in view of US Publication No. 2001/0037460 to Porcari (“Porcari”). Claims 11-14, 32, 34-36 and 62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran as applied to claims 45 and 63, and further in view of US Patent No. 6,662,178 to Lee (“Lee”). Claims 20 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran as applied to claims 45 and 63, and further in view of US Patent No. 6,434,580 to Takano et al. (“Takano”). Claims 21-23 and 42-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran as applied to claims 45 and 63, and further in view of US Patent No. 6,298,327 to Hunter et al. (“Hunter”).

This amendment amends claims 19, 20, 32, 33, 36-41, 45, 48-50, 58, 60, 63 and 64 and cancels claims 54-57. No claims have been added. Hence, after entry of this amendment, claims 11-17, 19-23, 32-53, and 58-64 will stand pending for examination.

Claim Amendments

Claims 19, 20, 32, 33, 36-41, 45, 48-50, 58, 60, 63 and 64 have been amended. The preamble of claim 45 has been amended to clarify that claim 45 is directed to a “computer amended method.” Claim 45 has also been amended for clarity to recite “providing a computer interface for a user to review one or more electronic documents, wherein the computer interface is configured to provide a prompt to allow the user to identify at least one electronic document as being relevant to a patent application.” Support for this amendment can be found throughout the application, including, specifically, at lines 18-30 on page 8 of the application. Claim 45 has also been amended to remove the now-redundant element that recited “allowing a user to identify the at least on relevant electronic document for disclosure to a patent office.”

In addition, claim 45 has been amended to recite “receiving, from the user and via the interface, a signal indicating that the at least one electronic document should be disclosed to the patent office,” and “in response to the signal, extracting, via an automated process and from the at least one electronic document, a set of information to be used in an information disclosure statement.” Support for these amendments can be found throughout the application, including, specifically, at lines 11-28 on page 9 of the application. Finally, the last element of claim 45 has been amended to recite “incorporating at least some of the extracted information . . .” for consistency with the amendments mentioned above.

Claims 63 and 64, which are directed to a system and a software program, respectively, and which correspond to claim 45, have been amended in similar fashion to claim 45. Claims 63 and 64 have also been amended, for clarity, to recite “a set of instructions executable” by a computer/processor, and each element has correspondingly been amended to recite “instructions to . . .” It is submitted that these amendments for clarity do not affect the scope of the claims.

The applicants appreciate the Examiner’s careful review of claim 60, which noted a typographical error. Claim 60 has been amended to correct that typographical error. Claims 19

and 20 have been amended to remove the term “computer,” as that term is considered unnecessary in light of the amendments to claim 45. Claims 32, 33, 36-41, 48-50 and 58 have been amended for consistency with the independent claims from which they depend.

Claim Objections

Claim 60 was objected to because of an informality. As noted, claim 60 has been amended, and it is believed that the amendment addresses the objection to claim 60. Reconsideration of that objection is respectfully requested.

§ 112 Rejections

Claims 55-57 were rejected under various paragraphs of § 112. While the applicants respectfully disagree with the grounds of those rejections, claims 54-57 have been canceled for consistency with the amendments to claim 45. Accordingly, it is believed that the § 112 rejections are now moot.

§ 103 Rejections

All pending claims were rejected under § 103(a) as being unpatentable over Petruzzi and Tran, taken, in some cases, in combination with other references. It is respectfully submitted that the amendments to independent claims 45, 63 and 64 overcome the rejections over Petruzzi and Tran.

Consider, for example, claim 45. The final office action notes that Petruzzi contemplates allowing a user to type information about a reference into an IDS. The office action also asserts that “typing in information about the reference is, in fact, identifying the reference.” Claim 45 has been amended to clarify the process by which the claimed invention identifies a relevant electronic document. Specifically, claim 45 recites that “the interface [for the user to review one or more electronic documents] is configured to provide a prompt to allow the user to identify at least one electronic document as being relevant to a patent application.” Neither Petruzzi teach or suggest that an interface, which is used to allow a user to review

electronic documents, might also provide a prompt to allow a user to identify one or more of those references as being relevant to a patent application. For at least this reason, claim 45 is believed to be allowable over the combination of Petruzzi and Tran. One skilled in the art surely would recognize that there is a patentable difference between, on the one hand, providing an interface for reviewing documents, within which is a prompt to allow a user to identify a document as relevant, and on the other hand, merely allowing a user to type in information about a relevant reference.

Moreover, claim 45, as amended, further recites “receiving, from the user and via the interface, a signal indicating that the at least one electronic document should be disclosed to the patent office,” and “in response to the signal, extracting, via an automated process and from the at least one electronic document, a set of information to be used in an information disclosure statement.” As noted above, the collective teachings of Petruzzi and Tran are limited to allowing a user to type information about a reference into an IDS. Nothing in either one of those references teaches or suggests the automatic extraction of information from an electronic document. As recited by claim 45, “at least some of the extracted information from the electronic document [is incorporated] into an electronic information disclosure statement.” Once again, the combination of Petruzzi and Tran fail to teach or suggest this element.

Consequently, it is believed that the combination of Petruzzi and Tran fail to teach or suggest multiple elements of claim 45, and that claim, correspondingly, is believed to be allowable over the cited combination. Moreover, since none of the other cited references provide the disclosure missing from Petruzzi and Tran, claim 45 is believed to be allowable over all of the cited references, and the applicants respectfully request reconsideration of the rejection of claim 45.

Claims 63 and 64 include elements substantially similar to those of claim 45 discussed above, and claims 63 and 64, therefore, are believed to be allowable for substantially similar reasons. Dependent claims 11-17, 19-23, 32-44, 46-53, and 58-62 are believed to be allowable at least by virtue of their dependence from allowable base claims.

Conclusion

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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Date: 8-21-06

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